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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,668	08/24/2001	Yasushige Nakamura	011071	1050

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EXAMINER

DOE, JANIS L

ART UNIT PAPER NUMBER

1756

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/935,668

Applicant(s)

NAKAMURA ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see the attached, paragraph 1.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached, paragraph 2.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 3-7, 9-11, 13, and 14.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____

Janis L. Dote
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PRIMARY EXAMINER
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1. The proposed amendments to claims 1, 7, and 11 add the limitation, the "second polyester resin being a polymerization product of polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane, polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and terephthalic acid in the absence of a crosslinking component." Said limitation was not present in the claims at the time the final rejection was mailed on Jan. 12, 2004 (CTFR011204), and therefore raises new issues.

The proposed amendments also raise a rejection under 35 U.S.C. 112, first paragraph, for lack of written description. As discussed in the rejection set forth in the final rejection in CTFR011204, paragraph 4, the specification discloses only two particular polyester resins, 2-2 and 2-3, that meet the softening point Tsp and acid value requirements recited in claims 1, 7, and 11. The proposed limitation to claims 1, 7, and 11 is not limited to the narrower disclosed resins 2-2 and 2-3, because it includes polyester resins that are not related to resins 2-2 and 2-3, such as, for example, polyesters that are obtained by other monomers not present in the two resins, or polyesters that do not have a Tsp of 80 or 100°C, the Tsp value of resins 2-2 and 2-3, respectively.

The proposed amendment to claim 1 raises a rejection of claim 5 under 35 U.S.C. 112, second paragraph, for lack of

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unambiguous antecedent basis. Instant claim 5 recites that the second polyester resin is a "polyester resin originating from an alkylene oxide adduct of bisphenol A represented" by the formula (I) recited in instant claim 5. The proposed amendment to claim 1 recites that the second polyester resin is a polymerization product of polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane. The "alkylene oxide adduct" of formula (I) recited in claim 5 is broader than the two narrower species recited in the proposed amendment. It is not clear whether the "alkylene oxide adduct" recited in claim 5 refers to the two narrower species recited in the proposed amendment or to other alkylene oxide adducts that may be present in the second polyester resin.

2. The examiner's refusal to enter the amendment filed after the final rejection on Jun. 14, 2004, renders moot applicants' arguments regarding the amendments to claims 1, 7, and 11. Accordingly, the rejection of claims 1, 3-7, 9-11, 13, and 14 stands.